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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/480,644	01/10/2000	Richard Allen Dunlap	CISCP118	4562
22434	7590	01/25/2005	EXAMINER	
BEYER WEAVER & THOMAS LLP			SING, SIMON P	
P.O. BOX 70250			ART UNIT	PAPER NUMBER
OAKLAND, CA 94612-0250			2645	

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	DUNLAP, RICHARD ALLEN	
09/480,644	Examiner	Art Unit
	Simon Sing	2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 30 July 2004.  
2a) This action is FINAL.                            2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-7,10-20,25 and 26 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) Claim(s) \_\_\_\_\_ is/are allowed.  
6) Claim(s) 1-7,10-20,25 and 26 is/are rejected.  
7) Claim(s) \_\_\_\_\_ is/are objected to.  
8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
    1. Certified copies of the priority documents have been received.  
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_.  
4) Interview Summary (PTO-413)  
    Paper No(s)/Mail Date \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 13 recites the limitation "the soft key label set" in line 7. There is insufficient antecedent basis for this limitation since there are more than one "soft key label set" recited in lines 1, 3 and 5 in the claim.
  
2. Claim 25 recites the limitation "the soft key label set" in line 8. There is insufficient antecedent basis for this limitation since there are more than one "soft key label set" recited in lines 2, 4 and 6 in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-7, 10-20, 25 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Macaulay et al. US 6,226,512.

3.1 Regarding claim 1, Macaulay discloses a portable handset 100 for use within a building in figures 1 and 2. Macaulay teaches:

receiving an incoming call for a user (column 6, lines 34-47);

sending the caller ID of a caller and a soft keys label set to portable handset for display (column 6, lines 60-67; column 7, lines 1-6, 22-35);

detecting, by a companion applications toolkit (CAT) server 218 (call manager object) that a menu (soft keys) selection from the portable handset is selected (column 7, lines 44-60);

upon receiving the menu selection, the processor (menu processing object) of the portable handset (which inherently has a processor since it is able to establish a data communication with computer 206) creates an event (answer), based on the selection, and passing the "ANSWER" option to the CAT and receiving a new soft key label set (column 7, lines 59-67; column 8, lines 1-13);

the processor determines that an answer mode is presently active on the portable handset (column 7, lines 59-67; column 8, lines 1-22);

display an appropriate soft key label set and caller attributes (column 8, lines 1-10; column 7, lines 22-29), wherein the event is associated with a soft key "ANSWER", and the event is processed by CAT resides outside the portable handset, and when the display changes, the soft key "ANSWER" is deactivated (column 8, lines 1-13).

3.2 Regarding claim 2, as discussed in claim 1, the CAT detects a soft key (menu) selection.

3.3 Regarding claim 3, as discussed in claim 1, the processor of the portable handset resides on the handset.

3.4 Regarding claim 4, Macaulay teaches retrieving a new soft key (menu) label set based on a selection (column 7, lines 59-67; column 8, lines 1-13).

3.5 Regarding claim 5, Macaulay teaches displaying a soft key label set (column 7, lines 22-29; column 8, lines 1-13).

3.6 Regarding claim 6, as discussed in claim 1, the processor of portable handset creates an answering event.

3.7 Regarding claim 7, Macaulay teaches a NAVKEY icon 114 corresponding to a buttons 122 and soft key icons (labels) 108-112 corresponding to buttons 116-120 (column 4, lines 16-23). Since the NAVKEY icon and the soft key icons are displayed in different display lines (figure 1), the portable handset is able to detect which display line (NAVKEY icon, or a soft key icon) is selected.

3.8 Regarding claim 10, Macaulay teaches the CAT sends a message to a switching controller (line interface) 204 for connecting the portable handset to a caller (column 7, lines 59-67; column 8, line 1).

3.9 Regarding claim 11, Macaulay teaches blanking out a display area (column 8, lines 5-13).

3.10 Regarding claim 12, Macaulay teaches a directories mode (column 5, lines 25-30), a service mode (answering a call) (column 8, lines 1-22), message (INFO) mode (column 5, lines 22-24). Macaulay further teaches voice messages (figure 3, step 308) a plurality of software applications 224 programmed with the CAT API (column 5, 15-22), so it is inherent that it includes a message mode for retrieving a voice message, and a setting mode for setting data and time of the portable handset.

3.11 Regarding claims 13 and 25, Macaulay teaches displaying a soft key label set on a portable telephone 100 which has a display. Macaulay teaches:

storing a plurality of soft key label sets, wherein a soft key label set has an application in a particular context and includes a plurality of text strings, such as a first soft key label set of “INFO”, “ANSWER” and “QUIT”, with an application to acquire caller’s information, to answer an incoming call, and to quit the current data communication session (column 7, lines 22-35);

retrieving a second set of soft key label, based on a particular context, such as ANSWER from a companion application toolkit server 218 (call manager object), which resides outside the portable telephone (column 7, lines 59-67; column 8, lines 1-13);

displaying the second set of soft key label set on the display, such that each text string (INFO or IGNORE) corresponds to a physical button on the portable telephone (column 8, lines 5-13); and

wherein, when the text strings change from the first soft key label set to the second soft key label set, the first soft key label set is deactivated (i.e. the second soft key label set is activated).

3.12 Regarding claim 14, Macaulay teaches an index (WAU\_SK\_CENTER) is invoked by a display line handler (CAT) and a call plane object (CAT) (column 7, lines 59-64).

3.13 Regarding claim 15, Macaulay teaches masking out ANSWER in the display while displaying the second soft key label set (column 8, lines 1-13).

3.14 Regarding claim 16, Macaulay teaches storing a plurality of soft key label sets, such the first and the second soft key label sets.

3.15 Regarding claim 17, Macaulay teaches a value for index is determined based on a particular context, such as ANSWER.

3.16 Regarding claim 18, Macaulay teaches validating a text string in the second soft key label set by masking (blanking) out "ANSWER" (column 8, lines 5-13).

3.17 Regarding claim 19, Macaulay teaches determining if the portable telephone is already in a data communication session (column 7, lines 3-17).

3.18 Regarding claim 20, Macaulay teaches determining the reason for an unsuccessful data session (column 7, lines 3-17).

3.19 Regarding claim 26, Macaulay discloses a computer for communicating with a portable handset 10 for use within a building in figures 1 and 2. Macaulay teaches:

receiving an incoming call for a user by a computer 206 (column 6, lines 34-47);

sending the caller ID of a caller and a soft keys label set to portable handset for display (column 6, lines 60-67; column 7, lines 1-6, 22-35);

detecting that a menu (soft keys) selection from the portable handset is selected (column 7, lines 44-60);

creating a message (answer) based on the selection (column 7, lines 59-64);

passing the message to a companion application toolkit (CAT) (menu processing object) (column 7, lines 7, lines 59-67; column 8, lines 1-4);

upon receiving the menu selection, the CAT creates an event (answer), based on the selection (column 7, lines 59-67; column 8, lines 1-10);

the CAT determines that an answer mode is presently active on the portable handset (column 7, lines 59-67; column 8, lines 1-22); display an appropriate soft key label set and caller attributes (column 8, lines 1-10; column 7, lines 22-29), wherein the event is associated with a soft key "ANSWER", and the event is processed by CAT (call manage object) resides outside the portable handset, and when the display changes, the soft key "ANSWER" is deactivated (column 8, lines 1-13).

4. Claims 1, 13, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Chewning III et al. US 5,416,831.

4.1 Regarding claims 1 and 26, Chewning discloses an ADSI compatible telephone 14 for communicating with a service node in figures 1 and 12 (column 3, lines 20-67; column 4, lines 1-5, 16-22; column 21, lines 22-38). Chewning teaches:

updating displayed textual information by selecting a soft key by a user on the telephone that is associated with desired information (column 6, lines 28-31; column 8, lines 45-49) (detecting a menu selecting form a menu on the telephone is selected);

interacting with a user through the information choices made with defined soft keys 27 (column 6, lines 26-28) and downloading one or more virtual pages to the telephone, display information and accompanying soft key function definitions (column 3, lines 24-26; column 6, lines 5-60; column 7, lines 24-41); (creating a message based

on the menu selection and passing the message to a menu processing object (an internal application), creating an event based on the menu selection);

displaying an appropriate menu label set and a plane display on a display monitor 26 of said telephone (figures 31-32; column 6, lines 24-31; column 4, lines 16-22; column 22, lines 50-68; column 23, lines 1-10);

the menu process object determining which mode from the plurality of modes (voice or data) is presently active in the telephone (column 3, lines 27-34), wherein the event is associated with a soft key and the event is processed by a call manager object (adjunct processor) outside the telephone 14 (column 3, lines 51-64; column 4, lines 16-22), and

wherein, when the TURNON soft key in figure 31C is pressed, the plane display changes from 31C to 31D, and the soft key TURNON is deactivated (disappeared) (column 28, lines 23-38).

4.2 Regarding claims 13 and 25, Chewning discloses an ADSI compatible telephone 14 for communicating with a service node in figures 1 and 12 (column 3, lines 20-67; column 4, lines 1-5, 16-22; column 21, lines 22-38). Chewning teaches:

storing a plurality of soft key label sets wherein a set key label set has a particular context (functions), includes a plurality of text strings and retrieving a soft key label set based on the particular context from a call manger object (application based on a service node), and displaying the soft key label on the telephone (column 3, lines 51-

64, column 4, lines 16-22; column 6, lines 24-31, 51-66; column 7, lines 24-41). When the text strings of soft key labels change from figures 31C to 31D, such as when TURNON soft key in figure 31C is pressed, the soft key label set in 31C is deactivated (soft key label set in 31D is activated instead) (column 28, lines 23-38).

***Response to Arguments***

5. Applicant's arguments filed 07/30/2004 have been fully considered but they are not persuasive.

The applicant argues that a feature of deactivating soft key functions during a line plane change is included in the amended independent claims. However, this limitation is not clearly written into the claims. Claim 1 recites in the last line, for example, the phrase: "when the plane display changes", which is can mean after a change, is different from "during the line plane change", or "while the line plane display is changing, the soft key is deactivated". Furthermore, from a software point of view, since soft keys are remote from an application (no hardware interrupt, and no motivation for a software interrupt either), a soft key input detecting subroutine is called to detect whether a key is pressed, and when an input is detected, the software is branched to second subroutine, corresponding to the input, and the key input detecting subroutine is no longer running until the second subroutine is executed.

***Conclusion***

6. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.



S.S.

01/21/2005



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